

## **REMARKS**

Reconsideration of the application is respectfully requested.

### **I. Status of the Application**

The specification has been amended to update the cross-reference to the parent application and reflect its issuance as U.S. Patent No. 6,723,868. Claim 8 has been amended to incorporate the limitation of claim 9 that the racemate resolution is carried out using D-(-)- or L-(+)-tartaric acid. Accordingly, claim 9 has been canceled without prejudice. No new matter has been added to the application. Claims 8, 14, and 15 are pending. Because claims 14 and 15 have been withdrawn from consideration, only claim 8 is at issue.

### **II. Anticipation Rejection**

Claim 8 has been rejected under 35 U.S.C. § 102(b) as anticipated by Daluge (U.S. Patent Nos. 5,087,697 and 5,206,435; hereinafter referred to collectively as "Daluge"). Applicants respectfully traverse this rejection and request reconsideration.

Claim 8 has been amended to incorporate the limitation of claim 9, that the resolution is performed using D-(-)- or L-(+)-tartaric acid. Daluge does not disclose or suggest resolving the cyclopentene compounds recited in the claims with D-(-)- or L-(+)-tartaric acid. Rather, Daluge discloses resolving compounds with dibenzoyl-D-tartaric acid. Therefore, claim 8 is not anticipated. Accordingly, it is respectfully requested that the rejection be withdrawn.

### **III. Obviousness Rejection**

Claims 8 and 9 have been rejected under 35 U.S.C. § 103(a) as obvious over Daluge. According to the Examiner, Daluge teaches resolving a compound using a tartaric acid but not D-(-)-tartaric acid. The Examiner argues it would have been obvious to use D-(-)-tartaric acid because choosing a particular isomer involves only routine skill.

Daluge does not disclose or suggest using D-(-)-tartaric acid. Rather, Daluge describes resolving a racemic mixture of aminoalcohols with dibenzoyl-D-tartaric acid (col. 9, lines 51-60 of U.S. Patent No. 5,087,697). Daluge does not suggest to one skilled in the art that D-(-)- or L-(+)-tartaric acid could be substituted for dibenzoyl-D-tartaric acid.

Furthermore, dibenzoyl-D-tartaric acid in Daluge is expensive and requires a precise acetonitrile/ethanol extraction solvent that cannot be removed (*see* the present specification at page 2, line 33-page 3, line 6). The process of the present invention does not suffer from these shortcomings. D-(-)- and L-(+)-tartaric acids do not require such solvents and are significantly cheaper than optically active forms of dibenzoyl-tartaric acid.

For the above reasons, Daluge fails to render obvious claim 8. Accordingly, applicants respectfully request withdrawal of the rejection.

#### **IV. Information Disclosure Statement**

Applicants have not yet received an initialed copy of the Form SB/08 submitted with the February 5, 2004 Information Disclosure Statement. Applicants respectfully request consideration of the references cited in the Information Disclosure Statement filed February 5, 2004, and that they be made of record in the prosecution history of the present application by initialing Form SB/08 next to each reference.

**V. Conclusion**

In view of the above amendments and remarks, applicants believe the pending application is in condition for allowance, which is earnestly solicited. If there are any remaining issues that the Examiner believes could be resolved through either a Supplemental Response or Examiner's Amendment, the Examiner is kindly requested to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

By 

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